HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P. O. Box 272400
Fort Collins, Colorado 80527-2400

PATENT APPLICATION

ATTORNEY DOCKET NO. ___10002960-1___

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s):   David Bohan

Application No.: 09/676,078

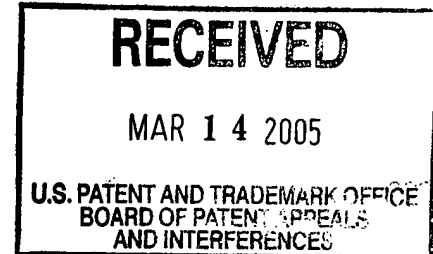Filing Date: Oct. 2, 2000

Title: Utilization of Third Party Legacy List

Confirmation No.: 4954

Examiner: Qamrun Nahar

Group Art Unit: 2124

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TRANSMITTAL OF APPEAL BRIEF

Sir:

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on **Jan. 7, 2005**___.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) $500.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

( ) (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)
      for the total number of months checked below:

( ) one month	$120.00	
( ) two months	$450.00	
( ) three months	$1020.00	
( ) four months	$1590.00	

   ( ) The extension fee has already been filled in this application.

(X) (b) Applicant believes that no extension of time is required. However, this conditional petition is
      being made to provide for the possibility that applicant has inadvertently overlooked the need
      for a petition and fee for extension of time.

Please charge to Deposit Account 08-2025 the sum of ___$500.00___. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

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Number of pages: 29

Respectfully submitted,

David Bohan

By _____

Jack H. McKinney

Attorney/Agent for Applicant(s)

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P. O. Box 272400
Fort Collins, Colorado 80527-2400

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David Bohan

By _____

Jack H. McKinney
Attorney/Agent for Applicant(s)

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PATENT APPLICATION
DOCKET NO. 10002960-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

INVENTOR(S): David Bohan

SERIAL NO.: 09/676,078   **GROUP ART UNIT:** 2124

FILED: October 2, 2000   **EXAMINER:** Nahar, Qamrun

SUBJECT: UTILIZATION OF THIRD PARTY LEGACY LIST

APPELLANTS'/APPLICANTS' OPENING BRIEF ON APPEAL

1.   REAL PARTY IN INTEREST.

The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holding, LLC.

2.   RELATED APPEALS AND INTERFERENCES.

There are no other appeals or interferences known to Appellants, Appellants' legal representative or the Assignee which will affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

3.   STATUS OF CLAIMS.

Claims 1-20 and 28-30 are pending and stand rejected. Claim 21-24 have been cancelled in a concurrently filed amendment. Claims 26 and 27 were previously cancelled.   All pending claims are appealed.

4.   STATUS OF AMENDMENTS.

A concurrently filed amendment seeks to cancel Claims 21-24. Per 37 C.F.R. § 41.33, the amendment should be entered as the cancellation of Claims 21-24 does not affect the scope of any other pending claims. All previous amendments have been entered.

5.   SUMMARY OF CLAIMED SUBJECT MATTER.

Claim 1 recites a method for providing a user of an application program with access one or more third party legacy data lists. The method includes the application program, upon starting, querying an operating system whether one or more plug-in modules are registered in a registry of the operating system. The one or more plug-in modules are capable of interfacing with corresponding respective ones of the one or more third party legacy data lists. See, e.g., Specification, page 4, lines 15-28, page 7, lines 6-10. Identification of the one or more third party legacy data lists are then received from the one or more plug-in modules found in the registry. See, e.g., Specification, page 7, lines 11-24. A list of the denitrified third party legacy data lists are then provided to the user through a user interface of the application program. See, e.g., Specification, page 7, lines 25-28. Claims 2-7 depend from Claim 1.

Claim 8 recites a system for providing access to one or more third party legacy data lists to a user of a computer system. The system includes one or more plug-in modules, each of which is capable of interfacing with an associated one of the third party data lists. Each plug-in module is registered in a registry of an operating system for the computer system. The system also includes an application program having a

user interface. The application program, upon starting, queries the registry to determine registered, that is to identify, ones of said one or more plug-in modules. The application program is responsible for querying each registered plug-in module for the names of the third party legacy data lists and to then provide a list of those names though the user interface. *See, e.g.,* Specification, page 4, line 29 through page 6, line 19 and Figs. 1 and 1A. Claims 9-13 depend from Claim 8.

Claim 14 recites a computer readable storage medium on which one or more computer programs are embedded. The computer programs are responsible for implementing a method of providing a user of an application program with access to one or more third party legacy data lists. The computer programs include instructions for causing the application program, upon starting, to query an operating system whether one or more plug-in modules are registered in a registry of an operating system. Each plug-in modules is capable of interfacing with a corresponding third party legacy data list. The computer programs are also responsible for receiving, from the queried plug-in modules, identifications of the respective third party legacy data lists and then providing a list of the identified third party legacy data lists to the user through a user interface of the application program. *See, e.g.,* Specification, page 4, line 29 through page 6, line 19 and Figs. 1 and 1A. Claims 15-20 depend from Claim 14.

Claim 25 recites computer readable medium storing one or more computer programs for providing an application with access to an unsupported third party legacy data lists. The one or more computer programs have instructions for receiving a request function call from the application program, and, in response, returning an identification of the third party legacy data list. The programs also have instructions for receiving an availability function call from the application program, and, in response, indicating whether or not the third party legacy data list is available. *See, e.g.,* Specification, page 6, lines 9-19.

Claim 28 recites a computer readable medium storing a plug-in module for providing an application program with access to a third party legacy data list not supported by the application program. The plug-in module includes an application program interface and a data list interface. The application program interface is responsible for receiving a request function call from the application program and responding with an identification of the third party legacy data list. The application program interface is also responsible for receiving an availability function call from the

application program and responding with an indication of whether or not the third party legacy data list is available as well as receiving a data function call from the application program. The data list interface is responsible for, in response to a data function call, interfacing with and access the third party legacy data list.   *See, e.g.*, Specification, page 6, lines 9-19 and Fig. 1A. Claims 29 and 30 depend from Claim 28.

6.   GROUNDS FOR REJECTION TO BE REVIEWED.

A.   Reliance on a non patent reference published by Information Builders to support a rejection under 35 U.S.C. §102(e) or 35 USC. §103/§102(e) is improper as that reference is not a patent reference and it is not enabling.

B.   The Information Builders reference does not teach or suggest querying an operating system registry for a plug-in capable of interfacing with a third party legacy data list or receiving from a plug-in an identification of one or more third party legacy data lists.

C.   The Information Builders reference does not teach or suggest a plug-in module having a application program interface capable of receiving a data function call and a data list interface capable of interfacing with and access the third party legacy data list in response to the data function call.

D.   The Examiner has failed to establish a prima facia case for obviousness in that the Information Builders reference and USPN 5,857,073 do not teach an application program that is a facsimile software and a legacy data list that is a list of names and telephone numbers stored by a legacy facsimile software that is different than the facsimile software that is the application program.

E.   The Examiner has failed to establish a prima facia case for obviousness in that the Information Builders reference and USPN 6,266,744 do not teach an application program that is an e-mail software and a legacy data list that is a list of e-mail addresses stored by a legacy software that is different than the e-mail software that is the application program.

F.   The Examiner has failed to establish a prima facia case for obviousness in that the Information Builders reference and USPN 6,134, 548 do not teach an application program that is a personal organizer software and a legacy data list that is contact information and appointment information stored using a legacy personal

organizer software that is different than the facsimile software that is the application program.

7.   **ARGUMENT.**

A.   **Ground for Rejection A (Claims 1-20, 25, and 28-30) – Reliance on non patent reference published by Information Builders (IB) to support a rejection under 35 U.S.C. §102(e) or 35 USC. §103/§102(e) is improper as that reference is not a patent reference and it is not enabling.**

Claims 1-4, 8-10, 14-17, 25, and 28-30 were rejected under 35 U.S.C. §102(e) as being anticipated by "Web 390 for OS/390 and MVS," published by Information Builders at http://www.informationbuilders.com/products/web390/pdf/web390.pdf. Claims 5-7, 11-13, and 18-20 were rejected under 35 U.S.C §103(a) as being unpatentable over the Information Builders reference in view of one or more other references.

Plainly, the Information Builders reference is not a patent reference. Thus, §102(e), which is directed to references in the form of patent applications, is not applicable in this case. Even if the Information Builders reference were a patent reference, to support a rejection under §102, or to function as a primary reference in support of a §103 rejection, a reference must be enabling, that is, it must "sufficiently describe the claimed invention to have placed the public in possession of it." In re Donohue, 766 F.2d 531, 533 (Fed. Cir. 1985); *see also, Paperless Accounting, Inc. v. Bay Area Rapid Transit System*, 804 F.2d 659, 665 (Fed. Cir. 1986). "Even if the claimed invention is disclosed in a printed publication, that disclosure will not suffice as prior art if it was not enabling. *Id.* While it is the Applicant's position that the Information Builders reference does not describe the claimed invention, even if it did, the Information Builders reference is not enabling. In other words, it does not enable the invention claimed in the present application.

The Information Builders reference (reference hereinafter as IB) is merely an product data sheet that describes the capabilities of a particular web server with no or minimal description of the underlying structure or sub-processes for implementing those functions. To summarize, IB describes a web server (IB web server) designed to offer access to mainframe based productions systems (referred to as CICS,

IMS/DC, TSO, and VM/CMS or "3270" applications) from any web browser. IB, page 1, paragraph 1. The IB web server supports "popular Web file formats." IB, page 1, paragraph 5. It supports CGI scripts, JavaScripts, and 3GL languages for accessing native MVS data. IB, page 1, paragraph 5. The IB web server is designed to provide a 3270 emulation mode in which a web browser plug-in can deliver "familiar 3270 green screens." IB, page 1, paragraph 6. The IB web server is also designed to provide an "HTML translation mode, which automatically converts 3270 datastreams into HTML forms." IB, page 1, paragraph 6.

Claim 1 recites a method of providing an access to one or more third party legacy data list to a user of an application program of a computer system and requires the following combination of elements:

1. querying an operating system, by said application program upon start of said application program, whether one or more plug-in module is registered in a registry of an operating system, said one or more plug-in modules being capable of interfacing with corresponding respective ones of said one or more third party legacy data list;

2. receiving, from said one or more plug-in modules found in said registry, identifications of ones of said one or more third party legacy data list corresponding to said found one or more plug-in modules; and

3. providing a list of said identifications to said user through a user interface of said application program.

Claims 2-7 depend from Claim 1.

IB mentions nothing of an underlying subsystem that is capable of performing these method steps. Nothing in IB teaches querying an operating system registry as to whether a plug-in capable of interfacing with a third party legacy data list is registered as required by the first limitation. IB describes a web browser (Netscape) plug-in that is capable if interfacing with the IB web server. There is no mention or suggestion that the web server plug-in is capable of interfacing with a third party legacy data list as required by the first limitation above. Even if there were, there is not discussion or suggestion of how. Moreover nothing in IB teaches or suggests receiving from a plug-in an identification of one or more third party legacy data lists let alone providing such a list though a user interface of an application program. Again, even if it did, there is no discussion or suggestion of how.

For at least these reasons, IB does not enable the invention of Claims 1-7.

Claim 8 recites a system for providing an access to one or more third party legacy data list to a user of a computer system and includes the following combination of elements:

1. one or more plug-in modules, each of which being capable of interfacing with an associated one of said one or more third party data list, each of said one or more plug-in modules being registered in a registry of an operating system of said computer system; and

2. an application program having a user interface, said application program upon starting being in communication with said operating system to query said registry to determine registered ones of said one or more plug-in module, said application program further configured to query each of said registered ones of said one or more plug-in modules for names of said one or more third party legacy data list, said application program being configured to provide a list of said names of said one or more third party legacy data list to said user through said user interface.

Claims 9-13 depend from Claim 8.

As discussed above with reference to Claim 1, IB does not describe a plug-in capable of interfacing with a third party legacy data list as required by the first limitation of Claim 8. Even if it did, there is no mention or suggestion as to how it might do so. Moreover, nothing in IB teaches or suggests an application program capable of querying plug-in modules to identify third party legacy data lists let alone providing such a list through a user interface. Again, even if there was, there is no mention or suggestion as to how.

For at least these reasons, IB does not enable the invention of Claims 8-13.

Claim 14 recites a computer readable storage medium on which is embedded one or more computer programs implementing a method of providing an access to one or more third party legacy data list to a user of an application program of a computer system. The one or more computer programs comprise a set of instructions for:

1. querying an operating system, by said application program upon start of said application program, whether one or more plug-in module is registered in a registry of an operating system, said one or more plug-in modules being capable of interfacing with corresponding respective ones of said one or more third party legacy data list;

2. receiving, from said one or more plug-in modules found in said registry, identifications of ones of said one or more third party legacy data list corresponding to said found one or more plug-in modules; and

3. providing a list of said identifications to said user through a user interface of said application program.

Claims 15-20 depend from Claim 14.

As discussed above with reference to Claims 1 and 8 above, nothing in these cited sections teaches querying an operating system by an application program whether a plug-in is registered where that plug-in is capable of interfacing with a third party legacy data list as required by the first limitation of Claim 14. Even if it did, there is no mention or suggestion as to how it might do so. Moreover, nothing in IB teaches or suggests receiving from plug-in modules identifications of third party legacy data lists let alone providing such a list through a user interface. Again, even if there was, there is no mention or suggestion as to how.

For at least these reasons, IB does not enable the invention of Claims 14-20.

Claim 25 recites a computer readable medium storing one or more computer programs for providing an application with access to an unsupported third party legacy data list. The one or more computer programs have instructions for:

1. receiving a request function call from the application program;

2. in response to the request function call, returning an identification of the third party legacy data list;

3. receiving an availability function call from the application program;

4. in response to the availability function call, indicating whether or not the third party legacy data list is available.

IB does not teach a program capable of interfacing with a third party legacy data list as required by the first limitation. IB describes a web browser (Netscape) plug-in that is capable if interfacing with the IB web server. That web server plug-in is

not capable of interfacing with a third party legacy data list as required by Claim 25. Even if it were so capable, IB provides no discussion or suggestion as to how it might do so. Moreover IB does not teach or suggest a computer program capable of receiving request and availability function calls let alone responding to such function calls as required by the remaining limitations of Claim 25. Again, even if it did, there is no mention or suggestion as to how.

For at least these reasons, IB does not enable the invention of Claims 25.

Claim 28 recites a computer readable medium storing a plug-in module for providing an application program with access to a third party legacy data list not supported by the application program. The plug-in module includes the following combination of elements:

    1. an application program interface operable to:
        a. receive a request function call from the application program and respond with an identification of the third party legacy data list;
        b. receive an availability function call from the application program and respond with an indication of whether or not the third party legacy data list is available; and
        c. receive a data function call from the application program; and
    2. a data list interface operable, in response to the data function call, to interface with and access the third party legacy data list.

Claims 29 and 30 depend from Claim 28.

IB does not describe or suggest a plug-in having the capabilities required by Claim 28. IB describes a web browser (Netscape) plug-in that is capable if interfacing with the IB web server. That web server plug-in is not capable of interfacing with a third party legacy data list as required by Claim 28. Even if it were so capable, IB provides no discussion or suggestion as to how it might do so. Moreover IB does not teach or suggests a program that is capable of making or responding to request, availability, or data function calls as required by Claim 28. Again, even if it did, there is no mention or suggestion as to how.

For at least these reasons, IB does not enable the invention of Claims 28-30.

B.   Ground for Rejection B (Claims 1-20) – The Information Builders reference does not teach or suggest querying an operating system registry for a plug-in capable of interfacing with a third party legacy data list or receiving from a plug-in an identification of one or more third party legacy data lists.

Claims 1-4, 8-10, and 14-16 were rejected under 35 U.S.C. §102(e) as being anticipated by IB. It is well settled that claim is anticipated if, and only if, each and every limitation set forth in the claim can be found expressly or inherently in a single piece of prior art.

Claims 1-4: As discussed above, Claim 1 recites a method for providing an access to one or more third party legacy data list to a user of an application program of a computer system and includes the following limitations:

1. querying an operating system, by said application program upon start of said application program, whether one or more plug-in module is registered in a registry of an operating system, said one or more plug-in modules being capable of interfacing with corresponding respective ones of said one or more third party legacy data list;

2. receiving, from said one or more plug-in modules found in said registry, identifications of ones of said one or more third party legacy data list corresponding to said found one or more plug-in modules; and

3. providing a list of said identifications to said user through a user interface of said application program.

The Examiner asserts these limitation are somehow taught by IB at page 1, paragraphs 1, 5, and 6. Nothing in the cited sections teaches querying an operating system registry for a plug-in capable of interfacing with a third party legacy data list as required by the first limitation. IB describes a web browser (Netscape) plug-in that is capable if interfacing with the IB web server. That web server plug-in is not capable of interfacing with a third party legacy data list as required by the first limitation above. Moreover nothing in the cited sections teaches or suggests receiving from a plug-in an identification of one or more third party legacy data lists let alone providing the such a list though a user interface of an application program as required by the second and third limitations above.

For these reasons, Claim 1 is felt to distinguish over IB. Claims 2-4 each depend from Claim 1 and include all of the limitations of that base claim. As such, Claims 2-4 are felt to distinguish over IB.

Claims 8-10: Claim 8 recites a system for providing an access to one or more third party legacy data list to a user of a computer system and includes the following limitations:

1. one or more plug-in modules, each of which being capable of interfacing with an associated one of said one or more third party data list, each of said one or more plug-in modules being registered in a registry of an operating system of said computer system; and

2. an application program having a user interface, said application program upon starting being in communication with said operating system to query said registry to determine registered ones of said one or more plug-in module, said application program further configured to query each of said registered ones of said one or more plug-in modules for names of said one or more third party legacy data list, said application program being configured to provide a list of said names of said one or more third party legacy data list to said user through said user interface.

The Examiner asserts that, for the same reasons Claim 1 is anticipated by IB, so is Claim 8. It is presumed then that the Examiner bases the rejection of Claim 8 on IB, page 1, paragraphs 1, 5, and 6. As pointed out above, nothing in these cited sections teaches a plug-in capable of interfacing with a third party legacy data list as required by the first limitation of Claim 8. Moreover, nothing in the cited sections teaches an application program capable of querying plug-in modules to identify third party legacy data lists let alone providing such a list through a user interface.

For these reasons, Claim 8 is felt to distinguish over IB. Claims 9 and 10 each depend from Claim 8 and include all of the limitations of that base claim. As such, Claims 9 and 10 are felt to distinguish over IB.

Claims 14-16: Claim 14 recites a computer readable medium with instructions for performing the method of claims 1. Claim 14 requires a computer readable medium with instructions for performing the following limitations:

1. querying an operating system, by said application program upon start of said application program, whether one or more plug-in module is registered in a registry of an operating system, said one or more plug-in modules being capable of interfacing with corresponding respective ones of said one or more third party legacy data list;

2. receiving, from said one or more plug-in modules found in said registry, identifications of ones of said one or more third party legacy data list corresponding to said found one or more plug-in modules; and

3. providing a list of said identifications to said user through a user interface of said application program.

The Examiner asserts that, for the same reasons Claim 1 is anticipated by IB, so is Claim 14. It is presumed then that the Examiner bases the rejection of Claim 14 on IB, page 1, paragraphs 1, 5, and 6. As pointed out above, nothing in these cited sections teaches a plug-in capable of interfacing with a third party legacy data list as required by the first limitation of Claim 8. Moreover, nothing in the cited sections teaches receiving from plug-in modules identifications of third party legacy data lists let alone providing such a list through a user interface.

For these reasons, Claim 14 is felt to distinguish over IB. Claims 15-17 each depend from Claim 14 and include all of the limitations of that base claim. As such, Claims 15-17 are felt to distinguish over IB.

Claims 5-7, 11-13, and 18-20: Claims 5-7 depend from Claim 1. Claims 11-13 depend from Claim 8, and Claims 18-20 depend from Claim 14. The Examiner rejected these Claims under §103 as being unpatentable over IB in view of various patent references. Claims 5-7 are felt to distinguish patentably over IB and these references based on their dependence from Claim 1. Claims 11-13 are felt to distinguish patentably over IB and these references based on their dependence from Claim 8. Claims 18-20 are felt to distinguish patentably over IB and these references based on their dependence from Claim 14.

C.   **Ground for Rejection C (Claims 25 and 28-30) – The Information Builders reference does not teach or suggest a plug-in module having a application program interface capable of receiving a data function call and a data list interface capable of interfacing with and access the third party legacy data list in response to the data function call.**

Claims 25 and 28-30 were rejected under 35 U.S.C. §102(e) as being anticipated by IB. Again, it is well settled that claim is anticipated if, and only if, each and every limitation set forth in the claim can be found expressly or inherently in a single piece of prior art.

Claim 25 recites a computer readable medium storing one or more computer programs for providing an application with access to an unsupported third party legacy data list. The one or more computer programs have instructions for:

1. receiving a request function call from the application program;
2. in response to the request function call, returning an identification of the third party legacy data list;
3. receiving an availability function call from the application program;
4. in response to the availability function call, indicating whether or not the third party legacy data list is available.

IB does not teach a program capable of interfacing with a third party legacy data list as required by the first limitation. IB describes a web browser (Netscape) plug-in that is capable if interfacing with the IB web server. That web server plug-in is not capable of interfacing with a third party legacy data list as required by Claim 25. Moreover IB does not teach or suggest a computer program capable of receiving request and availability function calls let alone responding to such function calls as required by the remaining limitations of Claim 25.

Claim 28 recites a computer readable media storing a plug-in module for providing an application program with access to a third party legacy data list not supported by the application program. The plug-in module is required to include:

1. an application program interface operable to

• receive a request function call from the application program and respond with an identification of the third party legacy data list;

- receive an availability function call from the application program and respond with an indication of whether or not the third party legacy data list is available; and
- receive a data function call from the application program; and

2. a data list interface data operable, in response to the data function call, to interface with and access the third party legacy data.

IB does not describe a plug-in having the capabilities required by Claim 28. IB describes a web browser (Netscape) plug-in that is capable if interfacing with the IB web server. That web server plug-in is not capable of interfacing with a third party legacy data list as required by Claim 28. Moreover IB does not teach or suggests a program that is capable of making or responding to request, availability, or data function calls as required by Claim 28.

For these reasons, Claim 28 is felt to distinguish over IB. Claims 29-30 each depend from Claim 28 and include all of the limitations of that base claim. As such, Claims 29-30 are felt to distinguish over IB.

D. **Ground for Rejection D (Claims 5, 11, and 18) – The Examiner has failed to establish a prima facia case for obviousness in that the Information Builders reference and USPN 5,857,073 do not teach an application program that is a facsimile software and a legacy data list that is a list of names and telephone numbers stored by a legacy facsimile software that is different than the facsimile software that is the application program.**

The Examiner rejected Claims 5-7 under Section 103(a) as being unpatentable over IB in view of Tsukamoto (USPN 5,857,073). To establish a prima facie case of obviousness under Section 103, the Examiner must show some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; that there is a reasonable expectation of success; and that the prior art reference (or references when combined) teach or suggest all the claim limitations. MPEP § 2142.

Claim 5 depends from Claim 4 which depends from Claim 1 and requires the following additional limitations not taught by IB or Tsukamoto:

1. the application program comprises a facsimile software; and

2. one or more third party legacy data list comprise one or more list of names and telephone numbers stored in a format that is not otherwise compatible with the application program using a legacy facsimile software.

Claim 11 is a system version of the method of Claim 5. Claim 18 is directed to a computer medium having instructions for performing the method of Claim 5.

Rejecting Claims 5, 11, and 18, the Examiner admits that IB does not teach the above limitations. Instead, with reference to the first limitation above, the Examiner cites Tsukamoto, col. 4, lines 10-18, col. 5, lines 16-65, col. 11, lines 14-16, and Fig. 5. The cited sections discuss a network made up of client terminals, a facsimile server, a file server, and a number of facsimile devices. Tsukamoto, col. 5, lines 16-26. A facsimile device includes a mailbox group stored in its own RAM, and the mail box group contains a number of mail boxes. Tsukamoto, col. 5, lines 17-35. Each mail box contains a mail box number, a user name, an identification ID, and addresses of received facsimile messages. Tsukamoto, col. 5, lines 36-40.

Upon receipt of a facsimile message for a particular user, a facsimile device writes an address in the reception message area of the user's mail box and stores the facsimile message in its memory at that address. Tsukamoto, col. 5, lines 41-46. 16-26 The facsimile server can then supply a user name and an identification, and the facsimile device will transfer the facsimile message to the facsimile server. Tsukamoto, col. 5, lines 46-49.

Fig. 5 illustrates a flow of changed registration data specific to a facsimile device. Tsukamoto, col. lines 54-55. Fig. 5 illustrates "setting data" stored in the RAM of a facsimile device and consisting of a name, a telephone number, and an auto reception indicator. Tsukamoto, col. 9, lines 63-65. Also illustrated is a general data group stored on the facsimile server. The setting data has been changed and differs from the general data. The general data is updated (presumably by some nondescript software operating on the facsimile server) to reflect changes made to the setting data. Tsukamoto, col. 10, lines 52-56.

While it is not clear, it is assumed that the Examiner is equating nondescript software running on a facsimile server with the facsimile software of Claim 5. It is also assumed that the Examiner is equating the general data with the list of names and

telephone numbers making up a legacy data list of Claim 5. Claim 5 clearly indicates that the legacy facsimile software (used to store the names and telephone numbers of a legacy data list) is different from the facsimile software that is the application program. The nondescript software running on Tsukamoto's facsimile server is more akin to the legacy facsimile software of Claim 5.

Neither IB or Tsukamoto, alone or in combination, teach an application program that is a facsimile software and a legacy data list that is a list of names and telephone numbers stored by a legacy facsimile software that is different than the facsimile software that is the application program. For this reason, Claims 5, 11, and 18 are felt to distinguish over the cited art.

E.   Ground for Rejection E (Claims 6, 12, and 19) – The Examiner has failed to establish a prima facia case for obviousness in that the Information Builders reference and USPN 6,266,744 do not teach an application program that is an e-mail software and a legacy data list that is a list of e-mail addresses stored by a legacy software that is different than the e-mail software that is the application program.

The Examiner rejected Claims 6, 12, and 19 as being unpatentable over IB in view of Sampath (USPN 6,266,744). Claim 6 depends from Claim 4 which depends from Claim 1. Claim 12, depends ultimately from Claim 8, and Claim 19 depends ultimately from Claim 14. For the same reasons Claims 1, 8 and 14 distinguish over IB, so do Claims 6, 12, and 19.

Nonetheless, Claim 6, requires the following additional limitations not taught by IB or Sampath

1. the application program comprises an e-mail software; and
2. one or more third party legacy data list comprises one or more list of names and e-mail addresses stored in a format that is not otherwise compatible with the application program using a legacy e-mail software.

Claim 12 is a system version of the method of Claim 6. Claim 19 is directed to a computer medium having instructions for performing the method of Claim 6.

Rejecting Claim 6, the Examiner admits that IB does not teach the above limitations. Instead, with reference to the first limitation above, the Examiner cites

Sampath, col. 4, lines 33-43. The cited section discusses a server computer that is programmed to generate invoices that can be sent, for example, via electronic mail. The cited section describes invoicing software not e-mail software as required by Claim 6.

With reference to the second limitation, the Examiner cites Sampath, col. 6, lines 15-18. This section describes a billing database (connected to the server computer) that can contain an e-mail address. While not clear, it is presumed that the invoicing software on the server computer is responsible for storing the e-mail address in the billing database.

Neither IB or Sampath, alone or in combination, teach an application program that is an e-mail software and a legacy data list that is a list of e-mail addresses stored by a legacy facsimile software that is different than the facsimile software that is the application program. For this reason, Claims 6, 12, and 19 are felt to distinguish over the cited art.

F.   Ground for Rejection F (Claims 7, 13, and 20) – The Examiner has failed to establish a prima facia case for obviousness in that the Information Builders reference and USPN 6,134, 548 do not teach an application program that is a personal organizer software and a legacy data list that is contact information and appointment information stored using a legacy personal organizer software that is different than the facsimile software that is the application program.

The Examiner rejected Claims 7, 13, and 20 as being unpatentable over IB in view of Gottsman (USPN 6,134, 548). Claim 7 depends from Claim 4 which depends from Claim 1. Claim 13, depends ultimately from Claim 8, and Claim 20 depends ultimately from Claim 14. For the same reasons Claims 1, 8 and 14 distinguish over IB, so do Claims 7, 13, and 20.

Nonetheless, Claim 7, requires the following additional limitations not taught by IB or Gottsman:

1. the application program comprises a personal organizer software; and

2. one or more third party legacy data list comprise one or more contact information and appointment information stored in a format that is not otherwise

compatible with the application program using a legacy personal organizer software.

Claim 13 is a system version of the method of Claim 7. Claim 20 is directed to a computer medium having instructions for performing the method of Claim 7.

Rejecting Claim 7, the Examiner admits that IB does not teach the above limitations. Instead, with reference to the first limitation above, the Examiner cites Gottsman, col. 37, lines 9-12. The cited section reads as follows:

A Personal Digital Assistant (PDA) with Internet access can synchronize the person's calendar, email, contact list, task list and notes on the PDA with the version stored in the Internet site. This enables the person to only have to maintain one version of this data in order to have it available whenever it is needed and in whatever format it is needed.

Neither IB or Gottsman, alone or in combination, teach an application program that is a personal organizer software and a legacy data list that is contact information and appointment information stored using a legacy personal organizer software that is different than the facsimile software that is the application program. For this reason, Claims 7, 13, and 20 are felt to distinguish over the cited art.

Respectfully submitted,
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APPENDIX OF CLAIMS INVOLVED IN THE APPEAL

1. A method of providing an access to one or more third party legacy data list to a user of an application program of a computer system, comprising:

querying an operating system, by said application program upon start of said application program, whether one or more plug-in module is registered in a registry of an operating system, said one or more plug-in modules being capable of interfacing with corresponding respective ones of said one or more third party legacy data list:

receiving, from said one or more plug-in modules found in said registry, identifications of ones of said one or more third party legacy data list corresponding to said found one or more plug-in modules; and

providing a list of said identifications to said user through a user interface of said application program.

2. The method of providing an access to one or more third party legacy data list in accordance with claim 1, further comprising:

adding to said computer system one or more additional plug-in module capable of interfacing with one or more additional third party legacy data list; and

registering said one or more additional plug-in modules in said registry of said operating system, said application program being configured to find said one or more additional plug-in modules when said application program is started after said addition of said one or more additional plug-in modules.

3. The method of providing an access to one or more third party legacy data list in accordance with claim 1, further comprising:

allowing said user to select a selected one of said one or more third party legacy data list from said list of identifications; and

allowing said user to edit at least one datum of said selected one of said one or more third party legacy data list through an edit user interface of said selected one of said one or more third party legacy data list, said application program communicating with said selected one of said one or more third party legacy data list through corresponding one of said one or more plug-in module.

4. The method of providing an access to one or more third party legacy data list in accordance with claim 1, further comprising:

allowing said user to select a selected one of said one or more third party legacy data list from said list of identifications; and

allowing said user to access at least one datum of said selected one of said one or more third party legacy data list through said user interface of said application program, said application program communicating with said selected to said one of said one or more third party legacy data list through corresponding one of said one or more plug-in module.

5. The method of providing an access to one or more third party legacy data list in accordance with claim 4, wherein:

said application program comprises a facsimile software; and

wherein said one or more third party legacy data list comprise one or more list of names and telephone numbers stored in a format that is not otherwise compatible with the application program using a legacy facsimile software.

6. The method of providing an access to one or more third party legacy data list in accordance with claim 4, wherein:

said application program comprises an e-mail software; and

wherein said one or more third party legacy data list comprise one or more list of names and e-mail addresses stored in a format that is not otherwise compatible with the application program using a legacy e-mail software.

7. The method of providing an access to one or more third party legacy data list in accordance with claim 4, wherein:

said application program comprises a personal organizer software; and

wherein said one or more third party legacy data list comprise one or more contact information and appointment information stored in a format that is not otherwise compatible with the application program using a legacy personal organizer software.

8. A system for providing an access to one or more third party legacy data list to a user of a computer system, comprising:

one or more plug-in modules, each of which being capable of interfacing with an associated one of said one or more third party data list, each of said one or more plug-in modules being registered in a registry of an operating system of said computer system; and

an application program having a user interface, said application program upon starting being in communication with said operating system to query said registry to determine registered ones of said one or more plug-in module, said application program further configured to query each of said registered ones of said one or more plug-in modules for names of said one or more third party legacy data list, said application program being configured to provide a list of said names of said one or more more third party legacy data list to said user through said user interface.

9. The system for providing an access to one or more third party legacy data list according to claim 8, further comprising:

an installer software configured to copy said one or more plug-in module to said computer system, said installer software further configured to registering said one or more copied plug-in modules in said registry of said operating system.

10. The system for providing an access to one or more third party legacy data list according to claim 8, wherein:

said user interface is configured to allow said user to select a selected one of said one or more third party legacy data list.

11. The system for providing an access to one or more third party legacy data list according to claim 10, wherein:

said application program comprises a facsimile software; and

wherein said one or more third party legacy data list comprise one or more list of names and telephone numbers stored in a format that is not otherwise compatible with the application program using a legacy facsimile software.

12. The system for providing an access to one or more third party legacy data list according to claim 10, wherein:

said application program comprises an e-mail software; and

wherein said one or more third party legacy data list comprise one or more list of names and e-mail addresses stored in a format that is not otherwise compatible with the application program using a legacy e-mail software.

13. The system for providing an access to one or more third party legacy data list according to claim 10, wherein:

said application program comprises a personal organizer software; and

wherein said one or more third party legacy data list comprise one or more contact information and appointment information stored in a format that is not otherwise compatible with the application program using a legacy personal organizer software.

14. A computer readable storage medium on which is embedded one or more computer programs, said one or more computer programs implementing a method of providing an access to one or more third party legacy data list to a user of an application program of a computer system, said one or more computer programs comprising a set of instructions for:

querying an operating system, by said application program upon start of said application program, whether one or more plug-in module is registered in a registry of an operating system, said one or more plug-in modules being capable of interfacing with corresponding respective ones of said one or more third party legacy data list;

receiving, from said one or more plug-in modules found in said registry, identifications of ones of said one or more third party legacy data list corresponding to said found one or more plug-in modules; and

providing a list of said identifications to said user through a user interface of said application program.

15. The computer readable storage medium in according to claim 14, wherein said one or more computer programs further comprising a set of instructions for:

adding to said computer system one or more additional plug-in module capable of interfacing with one or more additional third party legacy data list; and

registering said one or more additional plug-in modules in said registry of said operating system, said application program being configured to find said one or more additional plug-in modules when said application program is started after said addition of said one or more additional plug-in modules.

16. The computer readable storage medium in according to claim 14, wherein said one or more computer program further comprising a set of instructions for:

allowing said user to select a selected one of said one or more third party legacy data list from said list of identifications; and

allowing said user to edit at least one datum of said selected one of said one or more third party legacy data list through an edit user interface of said selected one of said one or more third party legacy data list, said application program communicating with said selected one of said one or more third party legacy data list through corresponding one of said one or more plug-in module.

17. The computer readable storage medium in according to claim 14, wherein said one or more computer program further comprising a set of instructions for:

allowing said user to select a selected one of said one or more third party legacy data list from said list of identifications; and

allowing said user to access at least one datum of said selected one of said one or more third party legacy data list through said user interface of said application program, said application program communicating with said selected to said one of said one or more third party legacy data list through corresponding one of said one or more plug-in module.

18. The computer readable storage medium in according to claim 17, wherein:

said application program comprises a facsimile software; and

wherein said one or more third party legacy data list comprise one or more list of names and telephone numbers stored in a format that is not otherwise compatible with the application program using a legacy facsimile software.

19. The computer readable storage medium in according to claim 17, wherein:

said application program comprises an e-mail software; and

wherein said one or more third party legacy data list comprise one or more list of names and e-mail addresses stored in a format that is not otherwise compatible with the application program using a legacy e-mail software.

20. The computer readable storage medium in according to claim 17, wherein:

said application program comprises a personal organizer software; and

wherein said one or more third party legacy data list comprise one or more contact information and appointment information stored in a format that is not otherwise compatible with the application program using a legacy personal organizer software.

21. A method of providing an application program with access to a third party legacy data list not supported by the application program, comprising:

supplying a plug-in module capable of providing an interface between the application program and the third party legacy data list;

the application program sending a request function call to the plug-in module;

the plug-in module, in response to the request function call, returning an identification of the third party legacy data list;

the application program sending an availability function call to the plug-in module; and

the plug-in module, in response to the availability function call, indicating whether or not the third party legacy data list is available.

22. The method of Claim 21, wherein:

supplying, comprises supplying a plurality of plug-in modules each capable of providing an interface between the application program and a corresponding third party legacy data list;

sending a request function call comprises the application program sending a request function call to each of the plug-in modules;

returning an identification comprises each plug-in module, in response to the request function call, returning an identification of its corresponding third party legacy data list;

sending an availability function cal comprises the application program sending an availability function call to each of the plug-in modules; and

indicating comprises each the plug-in module, in response to the availability function call, indicating whether or not its corresponding third party legacy data list is available.

23. The method of Claim 21, further comprising the application program displaying, if the third party legacy data list is available, at least an identification of the third party legacy data list in a user interface.

24. The method of Claim 23, further comprising the application interacting with the plug-in module to allowing a user to select, access, and modify the third party legacy data list.

25. A computer readable medium storing one or more computer programs for providing an application with access to an unsupported third party legacy data list, the one or more computer programs having instructions for:
receiving a request function call from the application program;
in response to the request function call, returning an identification of the third party legacy data list;
receiving an availability function call from the application program;
in response to the availability function call, indicating whether or not the third party legacy data list is available.

28. A computer readable medium storing a plug-in module for providing an application program with access to a third party legacy data list not supported by the application program, the plug-in module comprising:
an application program interface operable to:
receive a request function call from the application program and respond with an identification of the third party legacy data list;

receive an availability function call from the application program and respond with an indication of whether or not the third party legacy data list is available; and

receive a data function call from the application program; and

a data list interface operable, in response to the data function call, to interface with and access the third party legacy data list.

29. The medium of Claim 28, wherein:

the data list interface is operable to obtain a data set from the third party legacy data list; and

the application program interface is operable to respond to the data function call by supplying the data set to the application program.

30. The medium of Claim 28, wherein:

the data list interface is operable to obtain a data set from the third party legacy data list; and

the application program interface is operable to respond to the data function call by providing the application program with information required to present a user interface for adding datum to, modifying datum within, and deleting datum from the data set.